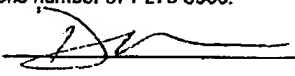
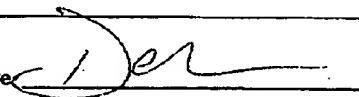


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| PRE-APPEAL BRIEF REQUEST FOR REVIEW (Re-Submission) | | Docket Number 1064 001 301 0202 |
| I hereby certify that this correspondence is being facsimile transmitted to the USPTO on <u>November 14, 2005</u> To telephone number 571-273-8300. | | Application Number 09/919,275 Filed July 31, 2001 |
| Signature  Typed name Duane C. Basch | | First Named Inventor Arthur PAPIER et al. |
| | | Art Unit 3621 Examiner K. ABDI |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed as a re-submission of the Pre-Appeal Brief Request For Review dated October 31, 2005, and subsequent to the Notice of Appeal submitted concurrently therewith, in response to the Notice of Panel Decision dated Nov. 8, 2005 (indicating failure to include reasons for review). This submission now includes the below-referenced reasons (5 pages) that were omitted from the prior Pre-Appeal Brief Request For Review.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> | | |
| <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number 34,545.</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.</p> <p><input type="checkbox"/> Registration number if acting under 37 CFR 1.34</p> <p>Signature  Typed name Duane C. Basch Telephone number 585-899-3970 Date Nov. 14, 2005</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.</p> | | |
| Total of _____ forms are submitted. | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450

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ARGUMENTS TO BE CONSIDERED BY PRE-APPEAL BRIEF CONFERENCE

PANEL

Rejection: Claims 1-15, 19, 22-24 and 28 were rejected under 35 USC §103(a) as being unpatentable over US 5,437,278 to Wilk (Wilk) in view of US 4,945,476 to Bodick et al. (Bodick). Claims 16-18 and 20-21 were newly rejected under 35 USC §103(a) as being unpatentable over Wilk in view of Bodick and further in view of US Application 2003/0036683A1 to Kehr et al. (Kehr).

Errors in Rejection: (I) inadequate basis for combination of Wilk and Bodick; (II) omission of element(s) recited in rejected independent claims; and (III) reliance upon "reference" not made of record and available after Applicants' priority date. These arguments are submitted in addition to the Response After Final (no amendments) submitted August 31, 2005, Applicants respectfully traverse the rejections.

I. In formulating the rejection under 35 USC §103(a) the Examiner improperly combines two patents that teach away from one another.

As to the basis for the alleged combination, the Examiner urges that it would have been obvious to modify Wilk to incorporate searching and image display as taught by Bodick. Applicants challenged this basis, and in response the Examiner has indicated that Wilk is interpreted as disclosing an aid to diagnosis. As noted previously (e.g., Response After Final), this is a mischaracterization of Wilk, which is directed to a "medical diagnostic system" (col. 4, line 29), where the relationship to a physician is stated as "eventually sees a physician for confirming the diagnosis" (col. 3, lines 64-65), and not as an aid. Automated diagnostic systems, such as disclosed by Wilk, are not designed to assist a user in diagnosis or the critical need to tolerate the ambiguity and complexity of medical diagnosis. Applicant respectfully stresses this distinction and the purposeful design of the claimed invention to aid recognition within the context of the inherent variation of human nature.

It also remains unclear what would have motivated one skilled in the art to modify Wilk's automated medical diagnostic system to make it "unautomated" and used for searching of case data. No motivation is found in Bodick to suggest making Wilk's automated

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diagnostic system a manual system. Accordingly, Applicants respectfully urge that the various statements of Bodick and Wilk would suggest that the teachings were not combinable, and certainly do not support the proposed modification of Wilk. In light of such teachings, Applicants respectfully urge that the modification of Wilk in view of Bodick is not supported by the references themselves, and was motivated solely by the limitations of the rejected claims, used as a "recipe" to select unrelated elements of the different patents. Accordingly, the rejection is traversed and claims 1, 3, 5 and 28 are respectfully urged to be in condition for allowance.

II. The rejection under 35 USC §103(a) omits elements recited in rejected independent claims.

Considering, *in arguendo*, the combination of Wilk in view of Bodick, at most such a combination teaches the use of a common collection of data or knowledge, for an automated medical diagnostic system. The modifications suggested by Bodick (with arguments to the contrary presented previously) would at most suggest that data of the Wilk system may be searched and text and/or an image from a case displayed to a user of the system as suggested by Bodick. Such a combination or modification does not, however, give rise to a user interface to solicit a plurality of descriptive characteristics of a sample requiring diagnosis as recited in claim 1. And, as noted above, neither Wilk nor Bodick teach the automated identification of a subset having a plurality of diagnoses, in response to characteristics. To assure proper consideration of these limitations, Applicants directed attention to pages 25 – 28 of the specification, and Figures 12 and 14, which describe and illustrate the response of the present invention to additional characteristics and the reordering of the information space (note the change in ordering of images/diagnoses in response to the addition of the "obesity" characteristic in window 292). Rather, the arguable combination teaches, at most, the manual searching of case records, and as suggested by Bodick, the display of images and text associated with the case record. Applicants respectfully submit that neither reference teaches the automatic reordering of an information space and concurrent presentation of a plurality of images for user review, as recited in independent claims 1, 3, 5 and 28; the claims are, therefore, patentably distinguishable over the arguable combination.

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With regard to claim 5, Applicants again incorporate the various arguments set forth previously with respect to claims 1 and 3. In particular, Applicants respectfully maintain that Wilk discloses an automated medical diagnostic system, whereas claim 5 recognizes the inherent problems with such systems and is intended, as recited in the preamble, to reduce diagnostic uncertainty – not as a substitute for a medical professional's diagnosis. Applicants respectfully contend that Wilk's automated diagnostic system teaches away from the visual aid system characterized by claim 5. While Wilk does disclose the storage of images, it does not disclose the recited user interface, the storage of images in an image database, separate from a cross-referenced knowledgebase, let alone the acknowledged failure to disclose or suggest the automatic reorganization of an information space and concurrent presentation of images for user review. Both Wilk and Bodick fail to address a solution for diagnosing when there are thousands of variations and images that are at the core of medical diagnosis and the biologic world. Like Wilk, Bodick also fails to teach or suggest the automatic identification of a subset including a plurality of diagnoses, and then using the subset, automatically reorganizing the information space to provide for its presentation to the user – using concurrent presentation of multiple images for review. Absent a teaching relative to the recited identification of a plurality of diagnoses, and the automated reorganization of the information space in an image database for concurrent presentation of images (specifically recited in claim 5), *prima facie* obviousness has not been established. Accordingly the rejection is traversed and claim 5, and all claims dependent therefrom, are respectfully urged to be patentably distinguishable over the arguable combination of Wilk in view of Bodick.

Relative to claim 28, in setting forth the rejection, the Examiner has failed to establish where each of the recited limitations is taught or suggested by the references relied upon – either alone or in combination. In particular, the Examiner acknowledged that none of the references of record is described as providing assistance in investigating a cause of death, nor are particular characteristics as to a manner of death, wound type, modality, etc. taught or suggested either by Wilk or Bodick. However, as in the rejection of claims 19 and 22-23, the Examiner nonetheless asserts that Bodick teaches the

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importance of using images and text "in any area where the appearance of an object under study/examination is of critical importance" as taught by Bodick at col. 9, lines 47-50. However, even if Bodick might be extended in the manner proposed by the Examiner, such an extension does not give rise to a basis for the rejection – nor does it teach the specific limitations set forth in a manner so as to have rendered it obvious to one of skill in the art at the time of the invention - particularly when the rejected claim recites specific limitations not found in the references. Applicants respectfully traverse the rejection of claim 28 and contend that *prima facie* obviousness has not been established so as to require or permit a further response.

III. The rejection over Wilk in view of Bodick and further in view of US Application 2003/0036683A1 to Kehr et al. (Kehr) relies upon a "reference" not made of record and available after Applicants' priority date

With regard to the new rejection of claims 16-18 and 20-21, Applicants previously acknowledged the Examiner's Official Notice as to use of icons. However, even if use of icons was known at the time of the invention, their use in the manner recited in the rejected claims is respectfully urged to be unknown and non-obvious. Moreover, the Official Notice was in conjunction with Wilk and Bodick, yet the Examiner did not indicate where the motivation for making use of icons was taught or suggested by either Wilk or Bodick.

Accordingly, Applicants' position was that Wilk needs no such icons as it is not a diagnostic aid, but an automated medical diagnostic system. Similarly, Bodick failed to suggest use of icons, and does not appear to teach or suggest the particular manner in which rejected claims 16-18 and 20-21 use such icons (e.g., symptoms represented as icons; icon indicates distribution of lesions on body; shape of medication, color). Absent some teaching or suggestion of the recited limitations, Applicants maintained the Official Notice was an attempt at a hindsight reconstruction of the claim elements using the claims as the recipe, and requested that in the event the rejection is maintained the Examiner set forth document(s) teaching all of the recited limitations, and indicate the motivation for such a combination.

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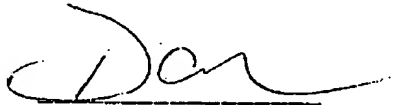
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In response to Applicants noting of the failure of the rejection to set forth a disclosure of all of the recited elements and establish *prima facie* obviousness, the Examiner rejected the claims, for the first time, relying upon a combination that included a new reference, Kehr (U.S. Publ. 2003/0036683). Applicants maintain that the Kehr publication is not available as a reference as it has a filing date (May 7, 2001) that is well after the earliest provisional application from which the instant application claims priority (e.g., Provisional Application No. 60/222,573, filed August 1, 2000, discloses the use of icons). In the event the rejection relies upon an earlier application by Kehr, Applicant notes that no such document has been made of reference or cited in the rejection. Accordingly, Applicants respectfully traverse the rejection, request that the rejection be withdrawn, and that claims 16-18 and 20-21 be indicated as allowable.

Conclusion: in view of the reasons set forth above, and in the Response After Final submitted on August 31, 2005, the Pre-Appeal Brief Conference Panel is respectfully requested to reconsider and instruct the Examiner to withdraw the present rejections.

Respectfully submitted,



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